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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,095	06/19/2001	Stephen Thomas Blocher	END920010013US1	2413

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HOFFMAN WARNICK & D'ALESSANDRO, LLC  
3 E-COMM SQUARE  
ALBANY, NY 12207

EXAMINER
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THAI, CANG G

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/884,095

Applicant(s)

BLOCHER ET AL.

Examiner

Cang G. Thai

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/19/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted on 06/19/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. whether the invention is within the technological arts; and
2. whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, Claim 1 is directed to "a method for reviewing a business process, comprising the step of:

providing a business process;  
identifying risks in the business process as control points; and  
arranging information pertaining to the control points in the template."

In the present case, Claim 1 does not require any technology. The recited steps for reviewing a business process does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all. The recited steps only constitute an idea for reviewing a business process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful (specific utility), concrete (repeatability and/or implementation without undue experimentation), and tangible (a real or actual affect) result.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is no clear what is the scope of the claimed invention and how the steps are implemented to achieve the scope of the claimed invention? Is it enhancing business development approach or maximizing the company market evaluation or launching a business. Applicant is recommended to insert an objective of the claimed invention in the preamble to improve clarity. Reviewing a business process is not a proper scope of the claimed invention.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0015375 (COGLIANDRO).

As for claim 1, COGLIANDRO discloses a method for reviewing a business process, comprising the step of:

providing a business process {See Fig. 1, Element 110};

identifying risks in the business process as control points {See Fig. 1, Element 120}; and

arranging information pertaining to the control points in a template {See Fig. 1, Element 130}.

As for claim 2, COGLIANDRO discloses the method of claim 1, further comprising the steps of:

identifying actions to address the risks {See Fig. 1, Element 140};

arranging the identified actions in the template {See Fig. 1, Element 150}; and

performing an audit using the template {See Fig. 1, Element 160}.

As for claim 3, COGLIANDRO discloses the method of claim 1, wherein the step of identifying risks comprises the step of implementing a set of tests to identify risks in the business process {See Fig. 2, Element "Likelihood Chart"}.

As for claim 4, COGLIANDRO discloses the method of claim 1, wherein the information comprises:

a set of tests, wherein the set of tests identify risks in the business process {See Fig. 3, Element "Consequence Chart"}; and

a set of actions, wherein the set of actions address the risks {See Fig. 3, Element "Technical Performance Factor"}.

As for claim 5, COGLIANDRO discloses the method of claim 4, wherein the information further comprises:

a business process {See Fig. 5, Element 510};

a test entity, wherein the test entity performs the set of tests {See Fig. 5, Element 520};

an action entity, wherein the action entity performs the set of actions; and audit details {See Fig. 5, Element 530}.

As for claim 6, COGLIANDRO discloses the method of claim 5, wherein the information further comprises:

a control point name {See Fig. 6, Element 610};

control point revisions {See Fig. 6, Element 620};

background information {See Fig. 6, Element 630}; and

a control point frequency {See Fig. 6, Element 640}.

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As for claim 7, COGLIANDRO discloses a method for reviewing a business process, comprising the steps of:

providing a business process {See Fig. 6, Element 610};

implementing a set of tests to identify risks in the business process as control points {See Fig. 6, Element 650};

identifying a set of actions to address the identified risks {See Fig. 6, Element 660}; and

arranging the set of tests and the identified actions in a template {See Fig. 6, Element 670}.

As for claim 8, COGLIANDRO discloses the method of claim 7, wherein the set of tests and the set of actions comprise control point information {See Fig. 6, Element 680}.

As for claim 9, COGLIANDRO discloses the method of claim 7, further comprising the steps of:

storing the template {See Fig. 10, Element 1020}; and

accessing the stored template to perform an audit {See Fig. 10, Element 1021}.

As for claim 10, which has the same limitations as in claims 7 & 9, respectively, therefore it is rejected for the similar reasons set forth in claims 7 & 9, respectively.

As for claim 11, which has the same limitation as in claims 8, therefore it is rejected for the similar reasons set forth in claim 8.

As for claim 12, COGLIANDRO disclose a method for arranging business process control point information in a template, comprising the steps of:

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Arranging a set of tests in a test field, wherein the set of tests identifies risks in a business process {See Fig. 6, element 670}; and

Arranging a set of actions in an action field, wherein the set of actions address the identified risks {See Fig. 6, Element 680}.

As for claim 13, COGLIANDRO discloses the method of claim 12, further comprising the steps of:

arranging a business process in a business process field {See Fig. 1, Element 110};

arranging a test entity in a test execution field, wherein the test entity performs the set of tests {See Fig. 1, Element 120};

arranging an action entity in an action execution field, wherein the action entity performs the set of actions {See Fig. 1, Element 130}; and

arranging audit details in an audit field {See Fig. 1, Element 140}.

As for claim 14, COGLIANDRO discloses the method of claim 13, further comprising:

arranging a control point name in a name field {See Fig. 5, Element 520};

arranging control point revisions in a revision field {See Fig. 5, Element 530};

arranging background information in an information field {See Fig. 5, Element 540}; and

arranging a control point frequency in an interval field {See Fig. 5, Element 580}.

As for claim 15, COGLIANDRO discloses the method of claim 12, further comprising the steps of:



storing the template {See Fig. 10, Element 1020}; and

performing an audit based on the stored template {See Fig. 10, Element 1018}.

As for claim 16, COGLIANDRO discloses a method for arranging business process control point information in a template, comprising the steps of:

arranging a business process in a business process field {See Fig. 6, Element 620};

arranging a set of tests in a test field, wherein the set of tests identifies risks in the business process {See Fig. 6, Element 630}; and

arranging a set of actions in an action field, wherein the set of actions addresses the identified risks {See Fig. 6, Element 640}.

As for claim 17, COGLIANDRO discloses the method of claim 16, further comprising the steps of:

arranging a test entity in a test execution field, wherein the test entity performs the set of tests {See Fig. 6, Element 620};

arranging an action entity in an action execution field, wherein the action entity performs the set of actions {See Fig. 6, Element 650}; and

arranging audit details in an audit field {See Fig. 6, Element 690};

storing the template {See Fig. 10, Element 1020}; and

performing an audit based on the stored template {See Fig. 10, Element 1018}.

As for claim 18, COGLIANDRO discloses the method of claim 17, further comprising:

arranging a control point name in a name field {See Fig. 6, Element 660};

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arranging control point revisions in a revision field {See Fig. 6, Element 670};  
arranging background information in an information field {See Fig. 6, Element 680}; and

arranging a control point frequency in an interval field {See Fig. 6, Element 690}.

As for claim 19, COGLIANDRO discloses a template for arranging business process control point information, comprising:

a test field for arranging a set of tests, wherein the set of tests identifies risks in a business process {See Fig. 5, Element 540}; and

an action field for arranging a set of actions, wherein the set of actions addresses the identified risks {See Fig. 5, Element 550}.

As for claim 20, COGLIANDRO discloses the template of claim 19, further comprising:

a business process field for arranging a business process {See Fig. 5, Element 530};

a test execution field for arranging a test entity, wherein the test entity performs the set of tests {See Fig. 5, Element 560};

an action execution field for arranging an action entity, wherein the action entity performs the set of actions {See Fig. 5, Element 570}; and

an audit field for arranging audit details {See Fig. 5, Element 580}.

As for claim 21, COGLIANDRO discloses the template of claim 20, further comprising:

a name field for arranging a control point name {See Fig. 6, Element 620};

a revision field for arranging control point revisions {See Fig. 6, Element 630};  
an information field for arranging background information {See Fig. 6, Element 640}; and  
an interval field for arranging a control point frequency {See Fig. 6, Element 650}.

As for claim 22, COGLIANDRO discloses the template of claim 19, wherein the risks comprise control points, and wherein the set of tests and the set of actions comprise control point information {See Fig. 9, Element "Three Dimensional Risk Chart With Metrics"}.

As for claim 23, which has the same limitations as in claim 16, therefore, it is rejected for the similar reasons set forth in claim 16.

As for claim 24, which has the same limitations as in claim 17, therefore, it is rejected for the similar reasons set forth in claim 17.

As for claim 25, which has the same limitations as in claim 18, therefore, it is rejected for the similar reasons set forth in claim 18.

As for claim 26, which has the same limitations as in claims 12 and 13, respectively, therefore it is rejected for the similar reasons set forth in claims 12 and 13, respectively.

As for claim 27, which has the same limitations as in claim 14, therefore, it is rejected for the similar reasons set forth in claim 14.

As for claim 28, COGLIANDRO discloses a program product stored on a recordable medium for arranging business process control point information in a template, comprising:

an interface for receiving business process control point information {See Fig. 10, Element 1020};

a template for arranging the received information, wherein the template comprises:

a test field for arranging a set of tests, wherein the set of tests identifies risks in a business process {See Fig. 10, Element 1010}; and

an action field for arranging a set of actions, wherein the set of actions addresses the identified risks {See Fig. 10, Element 1011}.

As for claim 29, COGLIANDRO discloses the program product of claim 28, wherein the template further comprises:

a business process field for arranging a business process {See Fig. 1, Element 110};

a test execution field for arranging a test entity, wherein the test entity performs the set of tests {See Fig. 1, Element 130};

an action execution field for arranging action entities, wherein the action entity performs the set of actions {See Fig. 1, Element 140}; and

an audit field for arranging audit details {See Fig. 1, Element 160}.

As for claim 30, COGLIANDRO discloses the program product of claim 29, wherein the template further comprises:

a name field for arranging a control point name {See Fig. 6, Element 660};

a revision field for arranging control point revisions {See Fig. 6, Element 670};

an information field for arranging background information {See Fig. 6, Element 680}; and

an interval field for arranging a control point frequency {See Fig. 6, Element 690}.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. U.S. Patent:

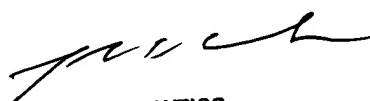
- 1) U.S. Patent Application Publication No. 2002/0099586 (BLADEN ET AL.) is cited to teach a system, method, and computer program product for risk assessment and interactive risk management,
- 2) U.S. Patent Application Publication No. 2002/0069035 (TRACY ET AL.) is cited to teach a computer-implemented system, method, and medium for assessing the risk of and/or determining the suitability of a system to comply with at least one predefined standard, regulation and/or requirement, and
- 3) U.S. Patent Application Publication No. 2002/0156644 (DAVIES ET AL.) is cited to teach a system, method and program product for separation of duties for business process risk management.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (703) 305-0553. The examiner can normally be reached on 6:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT  
3/18/2005

  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3300